

REMARKS

Applicants request reconsideration of the rejections of claims 22, 24-34, 36-44, 46-49, 52-75, and 78-79 under 35 U.S.C. § 103(e) stated in the Final Office Action dated May 16, 2008 in view of the Declaration of Christopher Darrow and the Supplemental Declaration of Christopher Darrow submitted herewith. A Request for Continued Examination is also submitted herewith.

On Page 2 of the May 16, 2008 Final Office Action, the 131 Declaration was deemed ineffective to overcome U.S. Published Patent Application No. 2004/0044532 to Karstens (“Karstens”), the reference cited under § 102(e). Applicants respectfully traverse this determination.

Attorney diligence that must be shown once the invention disclosure has been passed to an attorney for preparation of an application is substantially different than that which must be shown by an inventor. Applicants submit that the Declaration of attorney Christopher Darrow, in conjunction with the Supplemental Declaration of Christopher Darrow, attached to this response, clearly demonstrates conception of the claimed invention, well before the filing date of September 3, 2002 of Karstens, and continual attorney diligence from first disclosure of the invention to the attorneys in April 2002, and at least from before August 8, 2002 up until the constructive reduction to practice by the filing of U.S. Provisional Application Serial Number 60/421,255 on October 25, 2002.

The following sequence of events, when taken as a whole, supports the above assertion. Applicants submitted an invention disclosure on April 19, 2002 to Disney attorney Don Wenskay. See Inventors’ Declaration Exhibit A, submitted September 11, 2006. On April 24, Mr. Darrow began work on a draft provisional application based on this Invention Disclosure. See Darrow Declaration Exhibit 2. An initial draft application was sent to Mr. Wenskay on May 10, 2002. See Darrow Declaration Exhibit 3. We subsequently discussed the application with the inventors on at least May 30 and May 31 as evidenced by the handwritten notes provided in Darrow Declaration Exhibits 5 and 6. Thereafter Mr. Darrow received the April 25, 2002 revised Invention Disclosure, Rev. 3 and opened a new matter for this effort on July 17, 2002.

Darrow Declaration Exhibits 8 and 9. Mr. Darrow, as demonstrated by the time charges on Exhibits 2 and 9, and also Exhibit A of the Supplemental Declaration of Chris Darrow, periodically worked on the application, and enlisted the assistance of patent agent Ms. Maddux in detailed drafting of the application which ultimately was filed on October 25, 2002.

On August 8, 2002 the task of drafting the revised provisional application was given to patent agent Ms. Maddux by Mr. Darrow. During the period between August 8 and October 25, the task of drafting the revised provisional application was actively pursued as the drafting agent and inventor's availability permitted. During this time period Ms. Maddux was actively working on patent matters involving 12 different clients and 39 different matters as evidenced by Chris Darrow's Supplemental Declaration Exhibit B. Ms. Maddux diligently worked on these matters on a daily basis with the exception of taking normal days off, i.e. the weekends. At no time during this period did Ms. Maddux lay aside the invention or give preference to the preparation of an application of any later invention. There are no facts of record to indicate that Ms. Maddux was deliberately inactive. In fact, the record shows exactly the opposite.

In general, courts have held that a rule of reason should apply in determining attorney diligence. "We agree ... that a rule of reason should be followed in cases of this kind and that courts should be somewhat liberal in determination of diligence of attorneys and of their clerical and stenographic staffs, since the law cannot presume that such people can immediately begin and expeditiously perform their duties as soon as work appears on their desks." D'Amico v. Koike, 347 F.2d 867, 871 (CCPA 1965). Furthermore, a two-month period is reasonable in preparing a draft patent application. Sekine v. Seely, 826 F.2d 1073, (Fed. Cir. 1987) (holding that fifteen weeks is not an excessive amount of time to prepare a patent application for purposes of attorney diligence).

The Examiner, in the Final Office Action, asserts that there is no evidence supporting applicant's statement of diligence from just prior to September 03, 2002 to continuously through September 18, 2002, from September 20, 2002 - October 13, 2002, and from October 15, 2002 - October 22, 2002. On August 22, 2002 Ms. Maddux asked one of the inventors via e-mail to assist her in understanding the invention differences between related cases. From this point

forward Ms. Maddux diligently worked on multiple matters on a daily basis as is evidenced by the Supplemental Declaration of Christopher Darrow Exhibit B. "Reasonable diligence does not require a patent attorney engaged in a normal practice to concentrate on any one application to the exclusion of others." Martus & Becker v. Heise, 17 CCPA 1083, 39 F.2d 715, 5 USPQ 74, and Farmer et al. v. Schweiwer, 21 CCPA 865, 68 F.2d 961, 20 USPQ 281. During the 47 days from August 22, 2002 to October 9, 2002 Ms. Maddux had a backlog of cases/matters that she diligently worked on. Rines v. Morgan, 250 F.2d 365, 369, 116 USPQ at 148 states: "Of course, it may not be possible for a patent attorney to begin working on an application at the moment the inventor makes the disclosure, because the attorney may already have a backlog of other cases demanding his attention. Thus, the courts have recognized that reasonable diligence is all that is required of the attorney." In Rines 250 F.2d 365, citing Powell v. Poupitch, 35 CCPA 1080, 167 F.2d 514, 77 USPQ 379 it further states: "It is not necessary that an inventor or his attorney should drop all other work and concentrate on the particular invention involved; and if the attorney has a reasonable backlog of work which he takes up in chronological order and carries out expeditiously, that is sufficient." From the evidence shown in Exhibit B of Chris Darrow's Supplemental Declaration it is VERY clear that Ms. Maddux had a backlog of priority work she focused on and diligently worked on during this period and therefore, was unable to precisely start drafting the revised provisional application until October 9, 2002.

On October 9, 2002 Ms. Maddux reviewed the file including the invention disclosure and worked out issues with filing the provisional application. On this same day Ms. Maddux worked on two additional different matters. Then on October 14, 2002 Ms. Maddux received a supplemental disclosure from the inventors. On this same day she reviewed the supplemental disclosure with the previous disclosure. Ms. Maddux also worked on two additional different matters on this same day. On October 15, 2002 Ms. Maddux prepared the revised provisional application and also worked on one additional matter. On October 16, 2002 Ms. Maddux worked on the patent application and again worked on two additional different matters. On October 17, 2002 Ms. Maddux transmitted the draft provisional patent application to the Inventors for their review. Again on this day she also worked on two additional different

matters. On October 22, 2002 Ms. Maddux had a telephone conference with Inventor and worked on four additional different matters.

On October 23, 2002 Ms. Maddux received the inventor's comments on the draft provisional application. She revised the draft application according to inventor's comments. This included writing additional claims to cover the embodiments suggested by inventor. On this same day Ms. Maddux worked on seven additional different matters as well. On October 24, 2002 Ms. Maddux transmitted a second draft of patent application to inventors and also had a telephone conference with inventors. Also, on this same day Ms. Maddux worked on five additional different matters. On October 25, 2002 the provisional application was filed.

A normal day, week, or month of an attorney's work includes working on multiple matters all during the same time period. As is shown from the evidence, Ms. Maddux worked on at least two different matters every day, which is the normal practice of a patent attorney, or patent agent, in this case. The examples given above, taken from the time records of Exhibit B demonstrate that, although a 47 day period from August 22, 2002 - October 9, 2002 had lapsed between Ms. Maddux's first working on the present application and then picking up that task in earnest, Ms. Maddux never abandoned the application and, consistent with workload priorities, continued to work diligently on patent matters until her workload allowed for her to continue work on the patent application under discussion.

The Final Office Action of May 16, 2008 states that "It is unclear as to how/why Exhibit C is actually evidence regarding the constructive reduction to practice for the claimed invention ..." Exhibit C, line 16, is indicative of work in progress by Greenberg Traurig LLP, that of the preparation of the provisional patent application, which is evidence of the continued diligent work towards the Applicants' constructive reduction to practice. In support of this position, Darrow Declaration Exhibits 2 and 9 show that time was spent periodically between May 10 and October 25 by both Mr. Darrow and Ms. Maddux in preparation of the revised application that was filed on October 25, 2002. The time entries shown in Darrow Exhibits 2 and 9 further demonstrate that preparation of the application was being pursued in accordance with existing priorities as assigned prior to the critical date of September 3, 2002 until the filing

date of October 25, 2002. The September 19, 2002 status report, Exhibit C, simply further demonstrates that Ms. Maddux and Chris Darrow both had a backlog of other cases demanding their attention, of which they diligently worked on and that they never concealed, abandoned, or deliberately made this matter inactive.

The Examiner, in the Final Office Action, asserted that, without more, a two-day period of inactivity was fatal. "A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue)." MPEP § 2138.06. Applicants submit that In re Mulder does not stand for the proposition that two-days during the diligence period without evidence of diligence, while the rest of the period is full with evidence of diligence, would preclude an applicant from proving diligence. Rather, it says that even when the diligence period is as short as two-days, the applicant must show some evidence. In this case, Mulder sent his application that had been previously prepared outside the US to the US office of the Applicant more than two months before it was filed outside the US. No explanation for the two month delay until filing was given. Thus, what made Mulder's case fatal was that no evidence of diligence whatsoever by the applicant was provided by Mulder for over two months between the time the draft application was received in this country and the time the application was filed in the Netherlands. This period included the entire critical period of diligence. The court indicated that the applicant had to provide some proof of diligence during the critical diligence period. "A liberal construction of the rule ... will permit applicants to show diligence from just prior to the date of the reference to their ... filing date ... but liberality cannot be extended to the point of eliminating all proof of diligence, no matter how short the proof to be covered. Appellant's difficulty, as they have had to admit, is that there is no evidence whatever of record showing diligence, and therefore they cannot comply with the rule." In re Mulder, 716 F.2d 1542, 1545.

The present situation is completely different than In re Mulder. Unlike In re Mulder, where no applicant evidence of diligence was offered at all, the present Applicants now have provided, via the Declarations of Christopher Darrow, the preparing attorney, numerous

documents, both by the inventors and by their attorneys and agents, evidencing attorney diligence towards constructive reduction to practice of the instant invention.

Applicants submit that reasonable attorney diligence was, in fact, used at all times when preparing the provisional application throughout the entire critical period from just prior to September 3, 2002 to the filing date of October 25, 2002.

In the final Office Action of May 16, 2008, the examiner queried whether the inventor's e-mail statement in Exhibit F, was an admission:

"Is the examiner to conclude that per applicant's own admission that the subject matter disclosed and relied upon as evidence of conception is not actually unique/patentable and that only the additional subject matter contained in revision 3 should be considered inventive?"

It is respectfully submitted that this e-mail was submitted by an inventor who is not an expert in patent law and thus his statements do not act as an admission in any way. The inventor was opining about incompleteness of the disclosure that formed the basis of the first provisional draft. The additional material Mr. Nguyen was referring to is and was clearly indicated in Darrow Exhibit 8, which was documented as of April 25, 2002, well prior to the critical date of September 3, 2002.

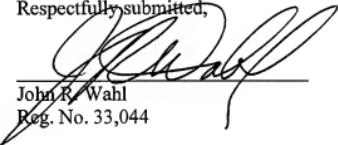
Finally, the first draft of the application was not submitted to the inventors for review on October 22, 2002. The first draft was submitted on May 10, 2002. Darrow Declaration Exhibit 3. The second draft was submitted to the inventors by Ms. Maddux on October 22, 2002. Activity by Mr. Darrow and Ms. Maddux between May 10 and October 22 is evident from the time entries shown in Darrow Exhibits 2 and 9, and Supplemental Declaration of Chris Darrow Exhibits A and B. These entries on June 18, July 16-31, August 8, August 22, and October 9-25 clearly demonstrate that there was continual attorney diligence from conception through constructive reduction to practice of the invention disclosed in the provisional application.

Accordingly, in light of the forgoing remarks it is submitted that Applicants have submitted more than sufficient evidence to demonstrate diligence during the critical period required. Reconsideration of the 131 Declaration, the Darrow Declaration, and consideration of

the Supplemental Declaration of Chris Darrow, and withdrawal of the 35 U.S.C. § 102/103(a) rejections to the claims are, therefore, respectfully requested.

This Response is accompanied by a Request for Continued Examination under 37 CFR 1.114. The commissioner is authorized to charge the required fee under 37 CFR 1.17(a) for a one month extension of time to reset the period for response to the Office Action so as to expire on September 16, 2008. The Commissioner is also hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2638. Please ensure that the Attorney Docket Number 54317-022501 is referenced when charging payments or credits for this case.

Respectfully submitted,


John R. Wahl
Reg. No. 33,044

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GREENBERG TRAURIG, LLP
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404
Phone: (310) 586-7700
Fax: (310) 586-7800
E-mail: wahlj@gtlaw.com